



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,498	09/29/2006	Kevin Taylor	007412.00070	9858

71867 7590 08/26/2009
BANNER & WITCOFF, LTD
ATTORNEYS FOR CLIENT NUMBER 007412
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

EXAMINER

SHEPARD, JUSTIN E

ART UNIT	PAPER NUMBER
----------	--------------

2424

MAIL DATE	DELIVERY MODE
-----------	---------------

08/26/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,498	Applicant(s) TAYLOR ET AL.	
	Examiner Justin E. Shepard	Art Unit 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/18/09 has been entered.

Response to Arguments

Applicant's arguments filed 5/18/09 have been fully considered but they are not persuasive.

Page 5, last paragraph; As answered in the previous Advisory Action:

The applicant argues that Addington does not teach transmitting “a notification of the customer order from the service provisioning system to the conditional access system.” Referring to figure 20a (and corresponding paragraphs 234-236), Addington teaches that a customer makes an order for a service at a Host Retailer in step 4, and in step 5 that this order is transmitted from the Host Retailer to the Conditional Access & Cable Headend through the Provisioning Server Gateway and the Billing System. This is considered as meeting the limitations found in claims 1 and 15 as the message is passed through a service provision system (Provisioning Server Gateway) and the billing system.

The remaining arguments rely on the independent claim being allowable, which it has been shown that it is not and therefore the argument is moot.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 8, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Addington in view of Eshun.

Referring to claim 1, Addington discloses a method of provisioning a set-top box (STB) with a STB provisioning system including a service provisioning system, a billing system, a conditional access system, a video device manager, and a provisioning datastore (figure 19), the method comprising:

storing STB profile information in the provisioning datastore (paragraph 236; figure 20a, step 5);

receiving a customer order at the service provisioning system (figure 20A; steps 4 and 5) independent of the conditional access system (figure 24; Note: as all the authorization for music downloading is sent and received through the ESS and not the conditional access system, this is interpreted as being an order placed independently of that system);

notifying the billing system of the customer order (paragraph 236);

transmitting a notification of the customer order from the service provisioning system to the conditional access system, the notification communicating customer desired cable operator services (figure 20A, step 5; paragraph 235);

storing information from the customer order in the provisioning datastore (paragraph 236);

notifying the video device manager about the STB (paragraph 236); and

delivering a cable operator configuration message from the video device manager to the STB (figure 20B, step 19), the configuration message being based on information from the provisioning datastore, thereby provisioning the STB without essential involvement of the conditional access system (figure 20B, step 11).

Addington does not disclose a method for receiving STB profile information independent of the conditional access system.

In an analogous art, Eshun teaches a method for receiving STB profile information independent of the conditional access system (figure 24).

At the time of the invention, it would have been obvious for ordinary skill in the art to add the factory set provisioning information taught by Eshun to the system disclosed by Addington. The motivation would have been to allow the system to be quickly authorized after purchasing the device.

Referring to claim 2, Addington does not disclose a method of claim 1 further comprising: storing STB certification information in the provisioning datastore.

In an analogous art, Eshun teaches a method of claim 1 further comprising:
storing STB certification information in the provisioning datastore (paragraph 58).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the STB certificate taught by Eshun to the method disclosed by Addington. The motivation would have been to enable the system to restrict access to specific information (Addington: paragraph 233).

Referring to claim 8, Addington discloses a method of claim 1 wherein the STB provisioning system further includes a data device manager, the method further comprising: notifying the data device manager about the STB (figure 20A, step 5).

Referring to claim 12, Addington discloses a method of claim 1 wherein the configuration message is sent using bi-directional unicast messaging (paragraph 106).

Referring to claim 13, Addington discloses a method of claim 1 wherein the configuration message is sent using uni-directional multicast messaging (paragraph 106).

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Addington and Eshun as applied to claims 1 and 2 above, and further in view of Steenkamp.

Referring to claim 3, Addington and Eshun do not disclose a method of claim 2 further wherein the STB certification information is instantiated as an XML formatted document.

In an analogous art, Steenkamp teaches a method of claim 2 further wherein the STB certification information is instantiated as an XML formatted document (paragraph 123).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the XML message protocol taught by Steenkamp to the method disclosed by Addington and Eshun. The motivation would have been to use an available protocol to save on development costs.

Referring to claim 4, Addington and Eshun do not disclose a method of claim 1 wherein the STB profile information is instantiated as an XML formatted document.

In an analogous art, Steenkamp teaches a method of claim 1 wherein the STB profile information is instantiated as an XML formatted document (paragraph 123).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the XML message protocol taught by Steenkamp to the method disclosed by Addington and Eshun. The motivation would have been to use an available protocol to save on development costs.

Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Addington and Eshun as applied to claim 1 above, and further in view of Cochran.

Referring to claim 5, Addington and Eshun do not disclose a method of claim 1 wherein the customer order is instantiated as an XML document.

In an analogous art, Cochran teaches a method of claim 1 wherein the customer order is instantiated as an XML document (column 11, line 65 to column 12, line 9).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the XML message protocol taught by Cochran to the method disclosed by Addington and Eshun. The motivation would have been to use an available protocol to save on development costs.

Referring to claim 9, Addington and Eshun do not disclose a method of claim 1 wherein the configuration message to the STB is instantiated as an XML document.

In an analogous art, Cochran teaches a method of claim 1 wherein the configuration message to the STB is instantiated as an XML document (column 11, line 65 to column 12, line 9).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the XML message protocol taught by Cochran to the method disclosed by Addington and Eshun. The motivation would have been to use an available protocol to save on development costs.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Addington and Eshun as applied to claim 1 above, and further in view of Jost.

Referring to claim 10, Addington and Eshun do not disclose a method of claim 1 wherein the configuration message to the STB includes configuration of the STB geographical location.

In an analogous art, Jost teaches a method of claim 1 wherein the configuration message to the STB includes configuration of the STB geographical location (column 9, line 64 to column 10, line 7).

At the time of the invention, it would have been obvious for ordinary skill in the art to add the location message taught by Jost to the method disclosed by Addington and Eshun. The motivation would have been to enable the device to not be installed in areas where it would be prohibited.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Addington and Eshun as applied to claim 1 above, and further in view of Freeman.

Referring to claim 11, Addington and Eshun do not disclose a method of claim 1 wherein the configuration message to the STB includes configuration to enable multiple channel lineups.

In an analogous art, Freeman teaches a method of claim 1 wherein the configuration message to the STB includes configuration to enable multiple channel lineups (paragraph 54).

At the time of the invention, it would have been obvious for ordinary skill in the art to add the multiple channel lineups taught by Freeman to the method disclosed by

Art Unit: 2424

Addington and Eshun. The motivation would have been to enable more viewing options to be provided to the users.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Addington and Eshun as applied to claim 1 above, and further in view of Rakib.

Referring to claim 14, Addington and Eshun do not disclose a method of claim 1 wherein the configuration message is sent in response to a boot-time request from the STB.

In an analogous art, Rakib teaches a method of claim 1 wherein the configuration message is sent in response to a boot-time request from the STB (paragraph 6).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the boot-time configuration taught by Rakib to the method disclosed by Addington and Eshun. The motivation would have been to enable the device to be moved to another location and still function on the network.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Addington in view of Eshun in view of Steenkamp in view of Cochran.

Referring to claim 15, Addington discloses a method comprising:

storing the STB profile information in a provisioning datastore (paragraph 236; figure 20a, step 5);

receiving a customer order at a service provisioning system (figure 20a, steps 4 and 5) independent of the conditional access system (figure 24);

notifying a billing system of the customer order (paragraph 236);

transmitting a notification of the customer order from the billing system to the conditional access system, the notification communicating customer desired cable operator services (figure 20a, step 5; paragraph 235);

storing information from the customer order in the provisioning datastore (paragraph 236);

notifying a video device manager about a STB corresponding to the STB profile information (paragraph 236); and

delivering a cable operator configuration message from the video device manager to the STB, the configuration message being based on information from the provisioning datastore, thereby provisioning the STB without essential involvement of the conditional access system (figure 20B, step 11).

Addington does not disclose a method for receiving STB profile information independent of a conditional access system; and

wherein the profile information, customer order, and configuration messages are XML formatted documents.

In an analogous art, Eshun teaches a method for receiving STB profile information independent of a conditional access system (figure 24).

At the time of the invention, it would have been obvious for ordinary skill in the art to add the factory set provisioning information taught by Eshun to the system disclosed by Addington. The motivation would have been to allow the system to be quickly authorized after purchasing the device.

Addington and Eshun do not disclose a method wherein the profile information, customer order, and configuration messages are XML formatted documents.

In an analogous art, Steenkamp teaches a method wherein the configuration message is an XML formatted document (paragraph 123).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the XML message protocol taught by Steenkamp to the method disclosed by Addington and Eshun. The motivation would have been to use an available protocol to save on development costs.

Addington, Eshun and Steenkamp do not disclose a method wherein the profile information and customer order are XML formatted documents.

In an analogous art, Cochran teaches a method wherein the profile information and customer order are XML formatted documents (column 11, line 65 to column 12, line 9).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the XML message protocol taught by Cochran to the method disclosed by Addington, Eshun and Steenkamp. The motivation would have been to use an available protocol to save on development costs.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

Art Unit: 2424

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Kelley/
Supervisory Patent Examiner, Art
Unit 2424

JS